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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,377	05/22/2000	James J. Hickman	215177-00101	2330

27160 7590 09/27/2006

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EXAMINER

ALLEN, MARIANNE P

ART UNIT PAPER NUMBER

1647

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/575,377

Applicant(s)

HICKMAN, JAMES J.

Examiner

Marianne P. Allen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/23/2006 and 7/25/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 51-61, 64-66 and 68-72 is/are allowed.
- 6) ☒ Claim(s) 62, 63, 67, 73 and 74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/25/2006 has been entered.

Claim 74 has been newly added. Claims 51-74 are under consideration by the examiner.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of claims under 35 U.S.C. 103(a) as being unpatentable over Borkholder et al. (US 6,377,057 B1) in view of Georger et al. (U.S. Patent No. 5,324,591) is withdrawn in view of the amendments to the claims.

Claim Rejections - 35 USC § 112

Claims 62-63 and 73-74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 67 does not appear to further limit claim 66 in that all nucleic acid sequences encompassed by claim 66 would have known or unknown function. As such, claim 67 does not appear to differ in scope. Applicant argues that claim 67 is further limiting as DNA could have

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no function. This is not agreed with. All DNA has some function even if it is not known at the present time and DNA with unknown function is already embraced by the claim.

Claims 62-63 lack antecedent basis in claim 51 for a surface modifying agent.

Claim 73 is confusing in reciting “deconvolution ... provides information on pathways in the cell.” The claim as written does not make clear what specific information must be provided to meet the limitation of the claims. Is it the name of the functional category? Is it the ion channels effected by the compound? The metes and bounds of the claim cannot be determined from the specification.

Claim 74 is directed to the method of claim 73 wherein said information on pathways in the cell involves reference to a data library of known compounds classified into one or more functional categories. The recitation “involves reference” in the claim does not make clear what positive, active step is to occur in the method. Furthermore, the claim does not make clear what particular information is present in the data library of known compounds. Is it the name of a compound? Is it the name of the functional category? Is it the ion channels effected by the compound? The metes and bounds of the claim cannot be determined from the specification.

Conclusion

Claims 51-61, 64-66, and 68-72 are allowable.

The art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schaffner et al. (Journal of Neuroscience Methods, 62:111-119, 1995) characterizes the NG108-15 cell line.

Mohan et al. (Biosensors and Bioelectronics, 21:1804-1811, 2006) demonstrates the claimed method.

The Schaffner et al. reference and a prepublication copy of the Mohan et al. reference were submitted by applicant in the 8/22/05 response but not made of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 571-272-0712. The examiner can normally be reached on Monday-Friday, 5:30 am - 2:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marianne P. Allen

Marianne P. Allen
Primary Examiner
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9/20/06